



Attorney Docket No. POS-03602/29

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Posa

Serial No.: 09/851,911

Group No.: 3728

Filed: May 9, 2001

Examiner: T. Kavanaugh

For: FOOTWEAR FOR PERSONALIZED FOOTPRINTS

APPEAL BRIEF UNDER 37 CFR §1.192

Box AF
Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

I. Real Party in Interest.

The real party in interest is the inventor, Mr. John J. Posa.

II. Related Appeals and Interferences.

There are no related appeals or interferences.

III. Status of Claims.

Claims 1, 3, 4 and 7-16 are pending in the application. Claims 7-10 are withdrawn from consideration and 1, 3, 4, 11-16 have been finally rejected and all are under appeal.

IV. Status of the Amendments.

No amendment has been filed subsequent to the final Office Action.

V. Summary of the Invention.

This invention improves upon the prior art by providing footwear for leaving a personalized imprint on wet sand and other surfaces through the removal of material as opposed to previous additive processes. (Specification, page 3, lines 4-6) The preferred embodiment comprises footwear with a sole portion having a bottom surface including a matrix of projections extending

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therefrom. Each projection is selectively removable, thereby enabling a user to remove a subset of the projections corresponding to the personalized imprint. The sole portion may form any type of shoe, including sandals, thongs, 'flip-flops,' and so forth. (Specification, page 3, lines 6-10).

Each projection preferably has a nominal length in the range of 3/16 to 3/8 inch and a nominal width in the range of 1/8 to 3/16 inch, and may be circular, triangular, rectangular, square, or hexagonal in cross-section. The matrix of projections may cover the entire bottom surface of the shoe, or a non-partitioned border may be provided which surrounds the matrix of projections. (Specification, page 3, lines 11-15) The sole portion may further be at least partially transparent, enabling the user to view the projections therethrough as they are being removed. (Specification, page 3, lines 15-17)

In use, a plurality of the projections are selectively removed to produce a mirror image corresponding to the personalized footprint. (Specification, page 3, lines 18-19) The sole portion is preferably such that it may be flexed to better expose projections to be removed. (Specification, page 3, lines 19-20) In the preferred embodiment, the composition of the projections is such that they may be removed by hand as through 'plucking' without tools, through a pocket knife, nail clippers, spoon or other common implement may come in handy. (Specification, beginning on page 3, line 20 through page 4, line2)

VI. Issues.

1. Were claims 1, 3, 4, 11-16 properly rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ellis (WO 91/11924)?
2. Were claims 11-12 properly rejected under 35 U.S.C. 103 (a) as being unpatentable over Ellis '924?
3. Was claim 6 properly rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924?
4. Was claim 15 properly rejected under 35 U.S.C. 103(a) as being unptentable over Ellis '924 in view of U.S. Patent No. 5,084,988 to Berger?

VII. Grouping of Claims.

Appellant believes the following group of claims represent patentably distinct subject matter warranting independent consideration by the Board:

Group 1: Claims 1, 3, 11, 12, 13 and 14, wherein claims 3, 11, 12, 13 and 14, stand or fall with claim 1.

Group 2: Claim 4

Group 3: Claim 15

Group 4: Claim 16

VIII. Argument

Group 1: Claims 3, 11, 12, 13 and 14 Stand or Fall with Claim 1.

Claim 1 stands rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over WO 91/11924 (Ellis). Claim 1 includes the limitations of a densely packed matrix of projections, each projection having a nominal length of 3/16 inch or greater and a nominal width of 1/8 inch or greater, and wherein each projection is removable enabling a user to remove a subset corresponding to a personalized imprint. Admittedly, Ellis teaches a shoe sole structure with deformation sipes such as slits or channels (151), but these are provided for an entirely different purpose namely, "for flexibility roughly equivalent to that of the foot." (See Abstract). In this regard, the Examiner states that the selection of a suitable size "would appear to constitute no more than optimisation of size by routine experimentation in as much as a number of thickness (sic) would appear to be suitable depending on the individual wearer and the type of footwear being constructed." (See final Office Action).

It doesn't negate the fact that they can be removed

Appellant does not disagree with this reasoning, but finds it to be flawed since the optimisation for the purposes of Ellis are entirely different than the optimisation for the purposes of Appellant. In particular, whereas the sole of Ellis is optimised to achieve conformality with the foot, presumably with all the projections inherently intact to further optimise that intended use, Appellant's projections are optimised for pluckability so as to create a personalized imprint. Although the Examiner states that Appellant has not demonstrated "or even alleged," that the specifically claimed size produces unexpected results, Appellant respectfully disagrees. The

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unexpected result is the ability to remove the projections, and based upon available materials, projections in the claimed size range would optimise that purpose.

Given that it is clearly the goal of Ellis to maintain a sole with integrity in terms of structure and construction, it would indeed be an unexpected result to remove a sufficient number of the projections to create a textual or graphical message while walking. Although Ellis does state that "the darkened areas of Figure 11A" can be removed to provide tread or cleat-like shoe soles, distinguishable contrast to Appellant's invention as claimed, the removed sections of the Ellis shoe sole would be filled with some other material such as a tread or cleat. Overall, given that the teachings of Ellis point to a shoe sole that either remains intact or is modified to provide even more traction, the reference teaches away from projection removability.

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Group 2: Claim 4.

Claim 4 includes a limitation of a non-partition border surrounding the matrix of projections. In rejecting this claim, the Examiner cites Figures 10A, 10B, and 10C of Ellis, which do appear to show a non-partition, but in the examples illustrated, it is not around a densely packed matrix of the projections. Given that Claim 4 adds limitations to Claim 1, and Claim 1 includes a densely packed matrix of projections in a particular size range, anticipation and obviousness are both precluded.

the outer ring in 10A-10C - the projection shown in Fig

Group 3: Claim 15.

Claim 15 includes the limitation of a sole portion which is at least partially transparent but with a tight matrix of projections extending therefrom, enabling the user to look through the sole portion and remove a subset corresponding to a personalized imprint. This claim stands rejected over Ellis in view of U.S. Patent No. 5,084,998 to Berger. The Examiner concedes that Ellis does not teach a sole which is at least partially transparent, but adds Berger on the grounds that it would "permit viewing of the toe tips." However, it is well settled that, to legitimately combine references for the purposes of an obviousness rejection, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley

How to find Unpredictable if one has limited data

Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, there is no teaching or suggestion whatsoever to make the sole portion of Ellis at least semi-transparent, and, moreover, the justification for doing so is clearly not the justification that Appellant recites in the subject claim.

repeat argument

Group 4: Claim 16.

Claim 16 includes the limitation of a sandal or thong including a sole portion with a densely packed matrix of projections and each projection being removable This claim stands rejected under 35 U.S.C. §103(a) over Ellis as well. In formulating the rejection, the Examiner states that Ellis teaches an invention that relates generally to the structure of shoes and, more specifically, "athletic shoes" (Page 1, Lines 4-6). Based upon this field of the invention, the Examiner states that it would have been obvious to provide the sole portion as taught above as part of a sandal or thong "to provide traction to the footwear." Appellant does not understand the Examiner's reasoning in this instance. How, Appellant wonders, does a sandal or thong provide more traction than an athletic shoe, which almost always includes laces to ensure that the shoe is firmly bound to the foot. Note Figure 1 of Ellis, which shows the heel portion of "a shoe, a conventional modern running shoe . . ." It would be absolutely clear and certain to anyone of skill in the art that Ellis teaches away from the consideration of a sandal or thong, thereby defeating prima facie obviousness.

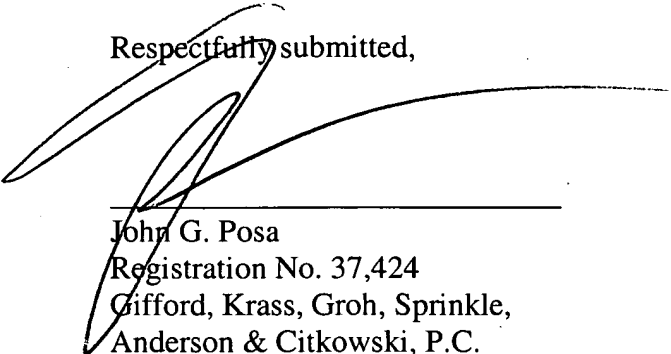
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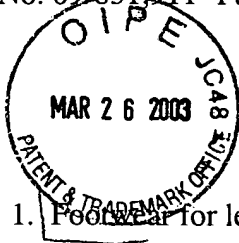
Based upon the foregoing, Appellant believes all pending claims continue to be in condition for allowance and seeks the Board's concurrence on a timely basis.

Respectfully submitted,

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APPEALED CLAIMS

1. Footwear for leaving a personalized imprint on wet sand and other surfaces, comprising:
(a sole portion having a bottom surface with a densely packed matrix of projections extending therefrom, the density of the packing being such that the projections are immediately adjacent to one another if not touching, and wherein:

each projection has a nominal length of 3/16 inch or greater, and a nominal width of 1/8 inch or greater, and

each projection is removable, enabling a user to remove a subset of the projections corresponding to the personalized imprint.

3. The footwear of claim 1, wherein the projections are circular in cross-section.

4. The footwear of claim 1, further including a non-partitioned border surrounding the matrix of projections.

11. The footwear of claim 1, wherein the projections are triangular in cross-section.

12. The footwear of claim 1, wherein the projections are rectangular in cross-section.

13. The footwear of claim 1, wherein the projections are square in cross-section.

14. The footwear of claim 1, wherein the projections are hexagonal in cross-section.

15. Footwear for leaving a personalized imprint on wet sand and other surfaces, comprising:

a sole portion which is at least partially transparent including a bottom surface with a tight matrix of projections extending therefrom,

each projection being removable, enabling a user to look through the sole portion and remove a subset of the projections corresponding to the personalized imprint.

16. Footwear for leaving a personalized imprint on wet sand and other surface, comprising:

a sandal or thong including a sole portion having a bottom surface with a densely packed matrix of projections extending therefrom,

each projection being removable, enabling a user to remove a subset of the projections corresponding to the personalized imprint.